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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,641

09/23/2005

Prasun K. Chakravarty

21230YP

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210 7590 03/04/2009  
MERCK AND CO., INC  
P O BOX 2000  
RAHWAY, NJ 07065-0907

EXAMINER

LEESER, ERICH A

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

03/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,641	<b>Applicant(s)</b> CHAKRAVARTY ET AL.	
	<b>Examiner</b> Erich A. Leeser	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-9,11-20,22,24-31,33-40 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33,38 and 43 is/are allowed.
- 6) ☒ Claim(s) 1,12,14,19,24,29 and 44 is/are rejected.
- 7) ☒ Claim(s) 2,7-9,11,13,15-18,20,22,25-28,30,31,34-37,39,40 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

This action is in response to Applicant's submission dated August 11, 2008, in which Applicant amended claims 1, 7-9, 11, 22, 24-31, and 45; cancelled claims 3-6, 10, 21, 23, 32, 41-42, and 46-58. Claims 1-2, 7-9, 11-20, 22, 24-31, 33-40, and 43-45 are pending and under examination.

#### ***Oath and Declaration***

Examiner apologizes for not being aware of the passing of inventor Michael H. Fisher.

#### ***Claim Rejections - 35 USC § 112***

Examiner previously rejected claims 1 and 37 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) Based on Applicant's amendment of claim 1, Examiner withdraws this rejection.
- ii) Based on Applicant's argument and revealing the mirror image aspects of HET-2, Examiner withdraws this rejection.
- iii) Based on Applicant's amendment of claim 37, Examiner withdraws this rejection.

#### ***Claim Rejections - 35 USC § 102***

Examiner previously rejected claims 1, 2, 7 and 44-45 under 35 USC 102(a) as being anticipated by Cao, et al., WO 02/096867. Based on Applicant's amendment of claim 1 adding a proviso thereby avoiding this reference, Examiner withdraws this rejection.

***Claim Rejections 35 U.S.C. § 103***

Examiner previously rejected claims 1, 14, 19, 29, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Katoh, et al., U.S. Patent No. 4,783,466 and claims 1, 12, 19, 24, and 44 under 35 U.S.C. § 103(a) as being unpatentable over Katoh, et al., U.S. Patent No. 4,873,248.

Instead of responding to Applicant's arguments, Examiner replaces these obviousness rejections with anticipation rejections, *infra*.

***New Grounds of Rejection***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 14, 19, 29, and 44 are rejected under 35 USC 102(b) as being anticipated by Katoh, et al., U.S. Patent No. 4,783,466. Katoh, et al. teaches pyrimidinyl compounds, which include instant compounds. Specifically, most of the compounds found in Tables 1 and 3-4, in columns 12-29 and 34-40 of the reference anticipate the aforementioned claims where R<sup>1</sup> is hydrogen, methyl or propyl; R<sup>2</sup> and R<sup>3</sup> are hydroxy and the other is hydrogen, hydroxy and the other is methyl, chloro and the other is hydroxy, hydrogen and the other is chloro, one is methyl and the other is chloro, both are hydrogen, one is methoxy and the other is hydrogen, one is methoxy and the other is methyl, one is hydrogen and the other is ethyl, one is ethoxy and the other is hydrogen, both are methyl, or both are chloro; R<sup>4</sup> and R<sup>5</sup> are either both hydrogen, one is hydrogen and the other is butyl, or one is methyl and the other is hydrogen;

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R<sup>6</sup>, R<sup>7</sup>, and R<sup>8</sup> are all hydrogen, one is methyl or ethyl and the other two are hydrogen, two are methyl and the other one is hydrogen, one is chloro or fluoro and the other two are hydrogen, or one is methyl, one is fluoro and the third is hydrogen, one is methoxy and the other two are hydrogen, all three are methyl, or two are chloro and the third is hydrogen. Because these exemplified compounds anticipate the instant compounds, the fact that they exhibit different activity is irrelevant.

Therefore, the instant claims 1, 14, 19, 29, and 44 are anticipated by Katoh, et al., U.S. Patent No. 4,783,466.

Claims 1, 12, 19, 24, and 44 are rejected under 35 USC 102(b) as being anticipated by Katoh, et al., U.S. Patent No. 4,873,248. Katoh, et al. teaches pyrimidinyl compounds, which include instant compounds. Specifically, most of the compounds found in Tables 1 and 3-4, in columns 11-22 and 24-27 of the reference anticipate the aforementioned claims where R<sup>1</sup> is methyl, ethyl or propyl; R<sup>2</sup> and R<sup>3</sup> are either both hydrogen, or one is hydrogen and the other is methyl; R<sup>4</sup> and R<sup>5</sup> are either both hydrogen, one is hydrogen and the other is chloro, methyl, methoxy, ethoxy, or propyl, one is methoxy and the other is methyl; one is hydroxy and the other is hydrogen or methyl, or one is methyl and the other is chloro; R<sup>6</sup>, R<sup>7</sup>, and R<sup>8</sup> are all hydrogen or chloro, one is ethyl, methyl, methoxy, bromo, fluoro or chloro and the other two are hydrogen, two are methyl or fluoro and the third is hydrogen, two are methoxy and the third is methyl, or all three are methyl. Because these exemplified compounds anticipate the instant compounds, the fact that they exhibit different activity is irrelevant.

Therefore, the instant claims 1, 12, 19, 24, and 44 are anticipated by Katoh, et al., U.S. Patent No. 4,873,248.

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***Claim Objections***

Claims 2, 7-9, 11, 13, 15-18, 20, 22, 25-28, 30-31, 34-37, 39-40, and 45 are objected to as being dependent upon rejected independent claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erich A. Leeser/

**/James O. Wilson/**

**Supervisory Patent Examiner, Art Unit 1624**

**Erich A. Leeser**

*Patent Examiner, Art Unit 1624*  
United States Patent and Trademark Office  
400 Dulany Street, Remsen 5C11  
Alexandria, VA 22314-5774  
Tel. No.: (571) 272-9932

**James O. Wilson**

*Supervisory Patent Examiner, Art Unit 1624*  
United States Patent and Trademark Office  
400 Dulany Street, Remsen 5A11  
Alexandria, VA 22314-5774  
Tel. No.: (571) 272-0661